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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,020	04/07/2006	Pierre Barberis	12467/9	7053
23280 7590 09/24/2008 Davidson, Davidson & Kappel, LLC 485 7th Avenue 14th Floor New York, NY 10018				
EXAMINER				
ZHU, WEIPING				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
09/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,020

Applicant(s)

BARBERIS ET AL.

Examiner

WEIPING ZHU

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 8-12 and 15-19 are currently under examination, wherein claims 8 and 15 have been amended in applicant's amendment filed July 9, 2008. In response to the Office action of a restriction requirement dated May 7, 2008, the applicant has elected the Invention of I, claims 8-12 and 15-19 without traverse in applicant's amendment filed on July 9, 2008. The applicant in the same amendment has withdrawn the non-elected Invention of II, claims 13 and 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-12 and 15-19 are rejected under 35 U.S.C. 103(a) as unpatentable over Diz et al. (US 6,544,361 B1).

With respect to claims 8-10 and 15-17, Diz et al. ('361 B1) discloses a process for producing a flat product made of a zirconium alloy having a Kearns factor of between 0.09 and 0.68 (col. 5, lines 6-9) comprising (col. 3, line 5 to col. 5, line 35):

casting an ingot having a composition comprising in percentages by weight of: 0.8-1.3% of Nb; less than 300 ppm of Sn; less than 0.25% of the total content of Fe, Cr and V; 10-35 ppm of S; 1100-1800 ppm of O; less than 120 ppm of Si; and a balance of Zr and inevitable impurities (col. 1, lines 43-62 and Table 1);

performing on the ingot at least one hot-rolling, a final hot rolling pass being carried out between 770-790 °C and not being followed by any quenching operation; optionally annealing the flat product not exceeding a temperature of 560 °C (example 3 includes this step while examples 1 and 2 do not include this step); and performing at least one cold-rolling/annealing cycle wherein the annealing cycle does not occur above 710 °C.

The value of the Kearns factor, the alloy composition and the annealing temperatures of Diz et al. ('361 B1) overlap the claimed ranges respectively. The hot-rolling temperature of Diz et al. ('361 B1) overlaps the claimed temperature range in the instant claims 8 and 15 and is close to the claimed temperature ranges in the instant claims 10 and 17. A prima facie case of obviousness exists. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed ranges within the disclosed ranges of Diz et al. ('361 B1) with expected success, because Diz et al. ('361 B1) discloses the same utility over the entire disclosed ranges.

With respect to claims 11 and 18, the final hot rolling temperature range of Diz et al. ('361 B1) reads on the claimed temperature range, because the final hot rolling temperature range of Diz et al. ('361 B1) overlaps or is close to the claimed temperature ranges as discussed in the paragraph above.

With respect to claims 12 and 19, Diz et al. ('361 B1) does not disclose the final hot rolling temperature range as claimed. However, it is well held that discovering an optimum value of a result-effective variable involves only routine skill in the art. In re

Boesch, 617, F.2d 272, 205 USPQ 215 (CCPA 1980). In the instant case, the final hot rolling temperature is a result-effective variable, because it would directly affect the final microstructure of the blank of Diz et al. ('361 B1) prepared for the following process steps as disclosed by Diz et al. ('361 B1) (col. 1, lines 6-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the final hot rolling temperature of Diz et al. ('361 B1) in order to achieve the desired microstructures as required. See MPEP 2144.05 II.

Conclusion

3. This Office action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

WZ

9/19/2008

Application Number**Application/Control No.**

10/575,020

**Applicant(s)/Patent under
Reexamination**

BARBERIS ET AL.

Examiner

WEIPING ZHU

Art Unit

1793